

### Remarks

The Applicant has amended claims 94 and 105 in response to the objection relating to the identification of which base wall is connected to the inner surface of the glass by the adhesive. The Applicant has amended each of the claims to recite that it is the base wall carrying the adhesive that is connected to the inner surface of the glass. The Applicant respectfully submits these amendments obviate the objection.

The current Office Action rejects claims 70-75 and 94-109 as being obvious in view of the combination of Baier and Roller. The Applicant respectfully traverses the rejection.

As an initial matter, the Applicant wishes to clarify the Applicant's position regarding the conclusions entered in the record of this application when the Restriction Requirement was made in 2004. As the Applicant has explained in its previous responses, the United States Patent and Trademark Office has made a ruling on the record of this application concluding that the Applicant's spacer inventions are distinct from the Applicant's muntin inventions. The current Office Action, at page 8, concludes that the restriction requirement "has no bearing on the propriety of the combination of references relied upon to reject claims to the elected invention." The Applicant respectfully disagrees. The United States Patent and Trademark Office has already made a decision – in the June 2, 2004, Office Action on record in this application – that Applicant's muntin inventions are patentably distinct from the Applicant's spacer inventions. The June 2, 2004, Office Action specifically concludes that the groups (muntins and spacers) are "distinct." Id. MPEP § 802.01 states "Related inventions are distinct if the inventions as claimed are not connected in at least one of design, operation, or effect (e.g., can be made by, or used in, a materially different process) and wherein at least one invention is PATENTABLE (novel and nonobvious) OVER THE OTHER (though they may each be unpatentable over the prior art). (emphasis added) The Applicant thus submits that the conclusions made to support the restriction requirement have important consequences in the propriety of future cited prior art combinations.

The Applicant's position is that if the Applicant's muntin inventions are patentable over the Applicant's own spacer inventions then it is a necessarily logical conclusion that the Applicant's muntin inventions are patentable over other third-party spacer-related prior art unless that third-party spacer-related prior art is somehow closer – or more relevant - to the Applicant's muntin inventions than the Applicant's own spacer inventions. Such prior art would have to disclose features that are closer to Applicant's claimed features than those already disclosed in Applicant's disclosed spacer material. The Applicant respectfully submits the references references cited to date are not closer and are not any more relevant than the Applicant's own disclosed spacer inventions – which the Office has already reviewed and found to be patentably distinct over the muntin inventions.

In response to the present rejection based on Roller, the Applicant notes that Roller discloses a spacer that is not any more relevant to the currently-claimed muntin inventions than the Applicant's spacer inventions. The Applicant thus again submits that claimed muntin inventions are patentable over the cited combination of references. The Applicant submits that one of ordinary skill in the art would not seek to combine features of unrelated inventions that have acquired a separate status in the art. One of ordinary skill in the art would thus not look to a spacer disclosure (Roller) to modify the muntin disclosure of Baier.

The Applicant additionally notes that the Roller reference discloses a rigid plastic spacer having large openings separated by a thin plastic partition 32'. Applicant's claims 75 and 94-109 each include limitations different from the large opening configuration disclosed in Roller. The Applicant thus respectfully submits these claims are also patentable because Roller does not disclose the claimed configurations of these claims.

The claimed muntins of the invention are rolled for storage as recited in claims 94 and 105. The recited configurations provide structures that have been found successful by the Applicant for these rolled applications. In addition, the muntins of the inventions are pressed onto glass with pressurized rollers that crush the muntins during the application process. Large cavity muntins collapsed and slid on the glass which was unacceptable. The Applicant has found the claimed

configurations to be successful in these application processes. Configurations such as that shown in the Roller spacer have been found to be unsuccessful as discussed in the Background of the Invention section of Applicant's specification (pages 2 and 3) wherein large cavity products did not succeed in the marketplace. The Applicant has thus claimed structures that are not found or suggested by the cited prior art references and has provided the problems that the claimed inventions overcome in the art. In view of the forgoing, the Applicant submits a *prima facie* case of obviousness thus has not been established and the claims are thus patentable over the cited combination of references.

The Applicant respectfully requests reconsideration of the claims and most earnestly solicits the issuance of a formal Notice of Allowance for the claims.

Please call the undersigned attorney if any issues remain after this amendment.



---

Fred H. Zollinger III

Registration No. 39,438

Certificate of Mailing

I hereby certify that this correspondence is being transmitted by facsimile to 571-273-8300 on July 13, 2010.



---

Fred H. Zollinger III, Reg. No. 39,438